

REMARKS

Claims 1-144 are in the application.

Claim 144 is new, and claims 1-95 and 102-103 and 110-143 are amended (either expressly or through amendment of a patent claim).

INTERVIEW SUMMARY

On October 4, 2004, applicant's undersigned attorney and Examiner Christine O. Sherr conducted a telephone interview. Mr. David Felsher, inventor, was present as an observer only.

During the interview, three topics were discussed.

(1) Ginter et al. vs. the present claims directed toward a legal trust.

Applicant's undersigned attorney first discussed the differences between a contractual agreement between parties, as described in Ginter et al., and a legal trust in which public interest and oversight is invoked. It was particularly noted that, in this sense, the word "trust" has two meanings, the ordinary meaning of a reliance on another person, or the specialized meaning (generally adopted in the present claims) relating to a legal entity in which a grantor (or donor) separates legal and equitable title to a corpus, which becomes the property of the legal trust, under control of a trustee, on behalf of a beneficiary.

While in many circumstances, a contractual agreement with a trusted party can yield the same result as a trustee acting under a trust agreement, in other cases the results are different, especially where there are exceptional circumstances or defaults. Likewise,

when judicial intervention is required, the result can also be markedly different. For example, if a party in a contractual agreement fails to fulfill its obligations, the result is typically a claim for damages, or, if the underlying agreement so permits, a reversion of property interests transferred under the Agreement. In contrast, under a legal trust, the result of a failure of the trustee to fulfill its responsibilities is a possible claim for breach of fiduciary responsibility, and the possible replacement of the trustee either under the terms of the agreement or by court order. Under a contract, the appointment of a replacement counterparty by a Court of law, not specified in the contract itself, would be quite rare. Therefore, by specifying a legal trust as the entity holding the rights, a significantly different logical structure, governed by different rules, and yielding significantly different results under a variety of circumstances is defined. Applicant's attorney therefore argued that the structures are distinct.

The Examiner noted that the statement of the invention and claim structure raises the issue whether applicant has merely substituted equivalents within a known system or business model. Applicant's attorney responded that the claims are amended herein (or in the case of claim 96, as originally presented) to be focused on the legal trust.

Applicant's attorney noted that, if substitution of the alleged equivalent yields a distinctly different result, which applicant argues is advantageous, and the modification is neither taught nor suggested in the prior art, then the result is a non-obvious invention. In this case, applicant has conceived that the existing limits to contractual relationships between parties have impeded the ability to define a relationship which serves various needs, including the centralization of access arbitration to medical records, while preserving

patient control and privacy. For example, a party to a contract, sued in his personal capacity, is subject to discovery on all aspects of his personal and business relationships, subject perhaps to a protective order imposed by a court. On the other hand, a trustee sued in his personal capacity has no right or obligation to disclose the private matters of the trust, and should not be forced by a Court to disclose these matters, even under protective order, if the suit is unrelated to the trust.

Therefore, Applicant submits that the claims represent a patentable conception.

The Examiner indicated that she would consider Applicant's arguments, but no agreement was reached.

(2) Non-Final subsequent Action.

Claim 96 is not amended herein. On review of the 35 U.S.C. Section 102 rejection of claim 96, it was agreed by the Examiner that the rejection under Ginter et al. does not address the particular claim elements, and would require at least a reformulation, if not being overcome, and therefore that, at least on that basis, the next Office Action would not be marked "Final". It is believed that this is reasonable and efficient, since this status allows both Applicant and Examiner to direct attention herein on a focal issue, the distinction between trusted party under contract and a legal trustee.

(3) Section 101 Rejection

Claims 140 and 141 were rejected under 35 U.S.C. Section 101. Applicant's undersigned attorney proposed the herein-above amendment to claim 140 to overcome this rejection, which the Examiner stated appears acceptable.

ARGUMENTS

Claims 140 and 141 are rejected under 35 U.S.C. § 101 as allegedly claiming non-statutory subject matter. Claim 140 has been amended to recite a monetary transfer or accounting entry, which is believed to comply with the requirements of the patent laws.

Claims 1-38, 53-57, 96-126 and 142-143 are rejected under 35 U.S.C. § 102(a) as being anticipated by Ginter et al. Claims 39-52, 58-95 and 127-139 are also rejected under 35 U.S.C. § 102(a) as being anticipated by Ginter et al.

Claims 1-126, as amended, make clear that the rights are held in a legal trust. The option of providing cryptographic security, a particular basis for rejection in view of Ginter et al., is no longer an element of the independent claims. Some claims also define a trustee and/or beneficiary under the trust. These are distinguished as set forth above, that is, the legal trust is distinguishable in non-obvious manner from a simple contract, and therefore the structures encompassed are patentable. It is noted that one of ordinary skill in the art would be well aware of these distinctions and respective characteristics, which are defined under both common law and statutory law, and there is no teaching or suggestion in the art that a legal trust structure would be advantageous for holding information rights or access rights associated therewith.

Claim 127 (as renumbered) is amended to recite that the medical transaction information files are subject to a separate role-based access rule, with an index search being role-based rule sensitive to withhold index information from unauthorized users. It is believed that this construct is neither taught nor suggested in the art.

Claim 140 (renumbered, as amended) recites an invention which comprises a business method for charging for access to a patient's medical record, on behalf of a patient, while logging requests and accesses. It is respectfully submitted that the art does not teach or suggest such a method.

Claim 142 (renumbered, as amended) recites a business method for establishing a "virtual information trust" for holding content records on behalf of a rights holder, and maintaining a log of requests and accesses. This construct is believed to be patentable on the same bases as argued above, that is, the virtual information trust invokes a different legal environment for operations, which result in different operation and results, especially in terms of legal presumptions for unusual situations and a different legal treatment of defaults. It is therefore respectfully submitted that this claim is patentable.

Claim 144 does not seek to distinguish Ginter et al. on the basis of the legal structure under which the information content is held. Therefore, for the purposes of this claim alone, which is otherwise similar to claim 58, the Examiner's interpretation of Ginter et

al. and its relation to the claimed method is adopted. Claim 144 is principally distinguished from Ginter et al. based on claim language:

automatically implementing, under control of the intermediary, the associated access rules with respect to the associated information content, the rules being implemented dependent on a context of attempted access; and

accounting, by the intermediary, for access to the information content and respective context.

In particular, Ginter et al. is not believed to operate and account in a context-sensitive manner.

It is noted that claims 140-141 were not subject to art rejection, and are therefore believed to be patentable.

It is respectfully submitted that the application now stands allowable. In the event that the Examiner disagrees, she is cordially invited to telephone the undersigned to continue the Interview to resolve outstanding issues and/or better understand Applicants position and arguments.

Respectfully submitted,



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